

### **REMARKS**

Claims 1-2, 5, 9, 11-16 and 18-21 are pending in this application after this amendment. Based on amendments and remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

By this amendment, Applicants have amended the claims to more appropriately recite the claimed invention. It is respectfully submitted that these amendments are being made without conceding the propriety of the Examiner's rejections, but merely to timely advance prosecution of the present application.

In the outstanding Official Action, the Examiner rejected claim 21 under 35 U.S.C. §112, first paragraph; rejected claim 21 under 35 U.S.C. §101; rejected claims 1-2, 11, 13-15 and 18-20 under 35 U.S.C. §103(a) as being unpatentable over Kowald (U.S. Patent Application Publication No. 2003/00027151) in view of Khan (U.S. Patent Application Publication No. 2003/0126121); rejected claims 5 and 9 under 35 U.S.C. §103(a) as being unpatentable over Kowald in view of Khan and further in view of Bhatt (U.S. Patent Application Publication No. 2002/0118883); rejected claim 12 under 35 U.S.C. §103(a) as being unpatentable over Kowald in view of Khan and further in view of Sano (USP 6,079,885); and rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Kowald in view of Khan and further in view of Tsukagoshi (USP 5,848,217). Applicants respectfully traverse these rejections.

#### **Claim Rejections – 35 U.S.C. §§112, 101**

The Examiner rejected claim 21 under 35 U.S.C. §112, first paragraph asserting “determining the total number of photographic images in each of the photographic image groups,” and “wherein when a total number of photographic images in one photographic group is larger than (less than) a predetermined threshold” are not supported in the specification. Applicants respectfully disagree with the Examiner's assertions.

The Examiner's attention is respectfully directed to page 18 line 22 through page 19, line 3, which discloses as follows:

The selection condition setting portion 20a obtains the number of photographic images within each of the groups G, and sets selection conditions based on the numbers according to the following rules.

1. Selection conditions are to be made stricter for groups having greater numbers of photographic images therein.
2. For groups containing only one image, the one image is selected as a qualified photographic image.

The Examiner is further reminded that exact claim terms need not be used in haec verba to satisfy the written description requirement of the first paragraph of 35 U.S.C. 112. *Eiselstein v. Frank*, 52 F.3d 1035, 1038, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995); *In re Wertheim*, 541 F.2d 257, 265, 191 USPQ 90, 98 (CCPA 1976).

As such, Applicants respectfully submit that claim 21 satisfies 35 U.S.C. §112, first paragraph. It is respectfully requested that the outstanding rejection be withdrawn.

With regard to the Examiner's rejection of claim 21 under 35 U.S.C. §101, Applicants have amended claim 21 to tie the method to a photographic image selecting apparatus. Based on this amendment, it is respectfully requested that the outstanding rejection be withdrawn.

#### **Claim Rejections – 35 U.S.C. §103**

By this amendment, Applicants have amended claim 1 to recite, *inter alia*, the selection condition setting means sets and stores the selection conditions, after the classifying means classifies the photographic images, for each similar photographic image group, so as to be stricter for similar photographic image groups having a greater number of photographic images included therein.

In contrast, metadata in Kowald is generated by cameras (see [0035], lines 12-14) or by the classification system 508 (see [0036], lines 6-8). The metadata is set and stored **before** the classification by the camera, or **during** the classification by the classification system 508.

However, claim 1 clearly requires the selection condition setting means, which is an equipment of the qualified photographic image extracting means and therefore separate from the classifying means, sets and stores setting conditions after the classifying means classifies the photographic images into similar photographic image groups. By providing such a structure, this enables the selection condition setting means to set the selection for each similar photographic image group defined by the classifying means.

Applicants respectfully submit that Kowald fails to teach or suggest the selection condition setting means as recited in claim 1. Applicants further respectfully submit that Khan fails to cure the deficiencies of the teachings of Kowald. As neither of the cited references, either alone or in combination, teach or suggest this claim element, Applicants respectfully submit that claim 1, as pending, is not obvious over the references as cited. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2, 5, 9 and 11-16 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1. It is further respectfully submitted that claims 18 and 21 include elements similar to those discussed above with regard to claim 1 and thus these claims, together with claims dependent thereon, are allowable for the reasons set forth above with regard to claim 1.

### **Conclusion**

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin et Reg. No.

52,328 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: May 4, 2009

Respectfully submitted,

By 

Marc S. Weiner  
Registration No.: 32,181  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000  
Attorney for Applicants